

102793-157
MBJ-0361**REMARKS*****Summary of Amendments Made***

Claims 3-9 and 11-17 are now pending.

Claim 3 has incorporated the claims elements of claims 1 and 2 into the claim. Support for the limitation for claims 4 and 5 can be found, for example, on page 4, lines 1-2 of the specification. Claims 11-17 have been amended to positively recite the presence of a cement mix. It is believed that no new matter has been added.

Objection to the Specification and 112, 1st paragraph (enablement) rejection

With regard to the variable M and component (B), the specification states that the polycarboxylic acid copolymer is inclusive of salts thereof (e.g. see page 1, lines 26-27 of the specification). Even in the absence of such a disclosure, one of ordinary skill in the art would know how to convert a carboxylic acid into a corresponding salt form.

With regard to the second issue raised under 112, 2nd paragraph, claims 11-17 now clearly recite the presence of a cement mix.

35 U.S.C. 112, first paragraph (written description) rejection

The procedure by which average molecular weight was calculated has been inserted into claims 4 and 5 (see page 4, lines 1-2 of the specification for an example of support for the limitation)

35 U.S.C. 112, second paragraph rejection

It is believed that the above amendments to the claims address the examiner's concerns. Should there be further issues on these grounds which preclude issuance of the Notice of Allowance, the applicants request that the examiner call the undersigned to discuss a possible Examiner's Amendment.

35 U.S.C. 102(b)/103(a) rejection

It is believed that the amendments made to the claims render the previous rejections moot.

Such that the previous rejections would be maintained, the applicants would present that for anticipation, MPEP 2131 states that to anticipate a claim, the reference must teach every element of the claim and quotes from *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d, 1913, 1920 (Fed. Cir. 1989) which states "The identical invention must be shown in as complete detail as is contained in the...claim." The references (as applied to the claims as amended) do not meet this standard.

In response to the alternative obviousness rejection and the examiner's statement that "...references exhibit all combinations of monomers, monomer ratios, molecular weights and polymer concentrations, any combination of the above variables would have been obvious to one of ordinary skill in the art...", the applicants reply that it has previously been held that "...*Determination of obviousness cannot be based on the hindsight combination of components selectively culled from the prior art to fit the parameters of the patented invention.*" see *ATD Corp. v. Lydall, Inc.*, 159 F.3d 534, 546, 48 USPQ2d 1321, 1329 (Fed. Cir. 1998).

102793-157
MBJ-0361

There must be a teaching or suggestion within the prior art; within the nature of the problem to be solved, or within the general knowledge of a person of ordinary skill in the field of invention, to look to particular sources, to select particular elements, and to combine them as combined by the inventor. see *Ruiz v. A.B. Chance Co.*, 234 F.3d 654, 665, 57 USPQ2d 1161, 1167 (Fed. Cir. 2000); *ATD Corp.*, 159 F.3d 546, 48 USPQ2d 1329; *Heidelberger Druckmaschinen AG v. Hantscho Commercial Prods., Inc.*, 21 F.3d 1068, 1072, 30 USPQ2d 1377, 1379 (Fed. Cir. 1994) ("When the patented invention is made by combining known components to achieve a new system, **the prior art must provide a suggestion or motivation** to make such a combination.") see *Crown Operations Int'l., Ltd. v. Solutia, Inc.*, 289 F.3d 1367, 62 USPQ2d 1917 (Fed. Cir. 2002).

Even if one could pick and choose elements from the selected references, MPEP 2144.05 section II (Optimization of Ranges) states that "A particular parameter must first be recognized as a result-effective variable, i.e., a variable which achieves a recognized result, before the determination of the optimum or workable ranges of said variable might be characterized as routine experimentation. *In re Antonie*, 559 F.2d 618, 195 USPQ 6 (CCPA 1977)." The collection of references do not direct one of ordinary skill in the art to do what the applicants have done.

Closing

Applicants also believe that this application is in condition for allowance. However, should any issue(s) of a minor nature remain, the Examiner is respectfully requested to telephone the undersigned at telephone number (212) 808-0700 so that the issue(s) might be promptly resolved.

Respectfully submitted,
Norris, McLaughlin & Marcus, P.A.

By: Howard C. Lee
Howard C. Lee
Reg. No. 48,104

220 East 42nd Street
30th Floor
New York, New York 10017
(212) 808-0700

CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that the foregoing Amendment under 37 CFR § 1.111 (8 pages total) is being facsimile transmitted to the United States Patent and Trademark Office on the date indicated below:

Date: 22 April 2003

By: Vilma I. Fernandez
Vilma I. Fernandez